II.   REMARKS

A.   OVERVIEW

Claims 1, 8, 16, 17, 19, 20, 22, 25, 27-29, 31, 33, 34, 36, 37, 39, 42-44, 50, 51, 53, 54, 56, 61, and 68-71 are pending in this application. No claims are cancelled by the instant response. Claims 1, 31, and 42 have been amended to clarify the claim language and include additional limitations. New claims 72-76 have been added by this amendment. Applicants respectfully submit that new claims 72-76 do not present any new matter, and are added in order to clarify the process of determining when requests are authorized. Support for new claims 72-76 can be found at least in paragraph [0029] of the specification.

The Final Office Action mailed February 22, 2007 rejected claims 1, 3, 4, 8, 16, 17, 19, 20, 22, 25, 27-34, 36, 37, 39, 42-44, 50, 51, 53, 54, 56, 61, and 68-71 (all pending claims) as being allegedly unpatentable over Hirka et al. (U.S. Publication No. 2003/0061157) in view of Dorf et al. (U.S. Patent 6,000,608) and further in view of Van Hoff (U.S. Patent No. 6,381,631).

B.   INDEPENDENT CLAIM 1

Independent claim 1 has been rejected as being allegedly unpatentable over Hirka in view of Dorf and further in view of Van Hoff. This rejection is respectfully traversed.

1.   Claim 1

Claim 1 recites, *inter alia*, a computerized method for securely authorizing and distributing stored-value card data over a communications network...comprising: "storing in a database a plurality of records comprising ... at least one of identifiers of trusted sources for making stored-value card processing requests, and information sufficient to identify trusted communications networks for carrying or transmitting stored-value card processing requests," "determining at the central processor at least one of: whether the respective requesting merchant terminal has a terminal identifier stored in the database and whether the communications network over which the request is received is identified in the database as a trusted communications network" and "responsive to a determination that the request was received over a trusted communications network, capturing the requesting terminal identifier and adding the terminal identifier to the database if not already stored."

2.   *Hirka, Dorf, and Van Hoff*

Hirka is generally directed to a system of accessing through a financial processing network multiple accounts associated with a single financial card. A user may utilize Hirka's methods to select a particular account from a set of accounts that is associated with a single financial card. The user's selection may be used to route the transaction data through the financial processing network or may be used to read data regarding one of multiple accounts encoded on the card.

Dorf is generally directed to a multifunction card system that provides a card capable of serving as a prepaid phone card, a debit card, a loyalty card, and a medical information card. The multifunction card may have an identification number comprising a bank identification number that may assist in establishing communications, and can be used from point-of-sale systems, as it is treated as a credit or debit card.

Van Hoff is generally directed to a method and apparatus for controlling client computer systems, and enforcing operation of management software before a user is allowed to perform other tasks on the remote network. The method may enforce access rules for third party software to prevent unauthorized retrieval or deletion of information by the third party software.

3.   *Claim 1 is Not Unpatentable Over Hirka In View of Dorf and Further In View of Van Hoff*

In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference; 2) there must be a reasonable expectation of success; and 3) the prior art reference must teach or suggest all the claim limitations. *See* MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). For at least the reasons set forth below, the Office Action fails to make a prima facie case of obviousness for each rejection.

First, Applicants respectfully submit that the Office Action does not describe any motivation or suggestion to combine, but instead relies upon impermissible hindsight. With regard to Hirka in view of Dorf, it merely states "[i]t would have been obvious to one of ordinary skill in the art at the time of invention to modify Risafi [*sic* -- Hirka] to include the features

taught by Dorf. The motivation to combine is that retailers can remotely add value to a system card." The Office Action, p. 4. Rather than detail a motivation to combine, the Office describes the very problem that the Applicants' invention attempts to solve, mentions the references in general with a citation to an overly broad statement, and uses impermissible hindsight to combine.

With regard to Hirka in view of Dorf and further in view of Van Hoff, the Office states "[i]t would have been obvious to one of ordinary skill in the art at the time of invention to modify Risafi [sic -- Hirka] to include the features taught by Van Hoff. The motivation to combine is that users may only connect to third parties trusted by the system administration." The Office Action, p. 4. This combination is even more troublesome. Van Hoff and Hirka are not in analogous arts. Hirka is classified in 705/39 ("Data processing: financial, business practice, management, or cost/price determination - Finance - Including funds transfer or credit transaction"); Van Hoff is classified in 709/202 ("Electrical computers and digital processing systems: multicomputer data transferring - Distributed Data Processing - Processing Agent").

Second, there is no reasonable expectation of success for the combination of Hirka in view of Dorf and further in view of Van Hoff. The method claimed by Applicants, and impermissibly deemed obvious by the Office, relies upon a known terminal or network identifier to authorize transactions regarding the status of stored value cards The lack of other parties conducting similar businesses is evidence of the lack of a reasonable expectation of success.

Third, and most conclusively, even when combined Hirka, Dorf, and Van Hoff do not disclose, teach, or suggest all of the claim limitations of claim 1. More specifically, the references do not disclose, teach, or suggest at least the steps of "storing in a database a plurality of records comprising ... at least one of identifiers of trusted sources for making stored-value card processing requests, and information sufficient to identify trusted communications networks for carrying or transmitting stored-value card processing requests," "determining at the central processor at least one of: whether the respective requesting merchant terminal has a terminal identifier stored in the database and whether the communications network over which the request is received is identified in the database as a trusted communications network," "responsive to a determination that the request was received over a trusted communications network, capturing the requesting terminal identifier and adding the terminal identifier to the database if not already stored," and "activating, deactivating, reloading, refreshing, or refunding at the central processor

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the stored value card based on the determining step." Each of these steps is addressed in detail below.

"Storing in a database a plurality of records comprising...at least one of identifiers of trusted sources for making stored-value card processing requests, and information sufficient to identify trusted communications networks for carrying or transmitting stored-value card processing requests"

Applicants respectfully submit that Hirka in view of Dorf and further in view of Van Hoff does not disclose, teach, or suggest a database that stores "storing in a database a plurality of records comprising ... at least one of identifiers of trusted sources for making stored-value card processing requests, and information sufficient to identify trusted communications networks for carrying or transmitting stored-value card processing requests." The Office Action states that "Hirka does not explicitly teach...information identifying trusted sources and information identifying trusted communications networks." *See* Office Action, p. 3. In order to establish the element, the Office looks to Van Hoff, a reference in a non-analogous field of art, and states "Van Hoff teaches the steps of information identifying trusted sources for making stored-value card processing requests and information identifying trusted communications networks for carrying or transmitting stored-value processing requests." Office Action, p. 4. Yet, Van Hoff does not teach the recited step.

Van Hoff notes in its summary that "[a] list of trusted third party networks is maintained by the client computer system, and the method and apparatus only allows the user to connect to third party networks on the trusted list, eliminating the need for remote users to pass through the corporate network." Van Hoff, col. 3, lines 52-57. This reveals at least two (2) distinct differences between Van Hoff and the claim element. First, the present invention and the claim element in particular allow a third party to establish a communication with a user--not the other way around as Van Hoff requires. Second, the present invention does not establish communications between networks, but utilizes the characteristics of a network to determine that the client is indeed legitimate, and is allowed to conduct particular transactions (activation, deactivation, refresh, etc.). While the purpose of Van Hoff is to "eliminate the need for users to pass through the corporate network," the purpose of the claim element at issue is to determine whether the party attempting to conduct a transaction has the proper authorization to do so.

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*"Determining at the central processor at least one of: whether the respective requesting
merchant terminal has a terminal identifier stored in the database and whether the
communications network over which the request is received is identified in the database
as a trusted communications network"*

Again, the Office states that the base reference of Hirka does not disclose the above step,
but looks to Van Hoff. The incorrectly Office asserts that Van Hoff teaches ""determining at the
central processor at least one of: whether the respective requesting merchant terminal has a
terminal identifier stored in the database and whether the communications network over which
the request is received is identified in the database as a trusted communications network." Van
Hoff does not make such disclosure.

As noted above, Van Hoff states in its summary that "[a] list of trusted third party
networks is maintained by the client computer system, and the method and apparatus only allows
the user to connect to third party networks on the trusted list, eliminating the need for remote
users to pass through the corporate network." Van Hoff, col. 3, lines 52-57. This reveals at least
two (2) distinct differences between Van Hoff and the claim element. First, the present invention
and the claim element in particular allow a third party to establish a communication with a user--
not the other way around as Van Hoff requires. Second, the present invention does not establish
communications between networks, but utilizes the characteristics of a network to determine that
the client is indeed legitimate, and is allowed to conduct particular transactions (activation,
deactivation, refresh, etc.). While the purpose of Van Hoff is to "eliminate the need for users to
pass through the corporate network," the purpose of the claim element at issue is to determine
whether the party attempting to conduct a transaction has the proper authorization to do so.

*"Responsive to a determination that the request was received over a trusted communications
network, capturing the requesting terminal identifier and adding the terminal identifier to the
database if not already stored"*

Simply put, none of Hirka, Dorf, or Van Hoff disclose the step of "responsive to a
determination that the request was received over a trusted communications network, capturing
the requesting terminal identifier and adding the terminal identifier to the database if not already
stored." None of Hirka, Dorf, or Van Hoff disclose anything remotely similar to the recited step.

"Activating, deactivating, reloading, refreshing, or refunding at the central processor the stored value card based on the determining step"

As noted above, none of Hirka, Dorf, or Van Hoff disclose the step "activating, deactivating, reloading, refreshing, or refunding" stored value cards. Moreover, the extent of the disclosure of Dorf of activating is clearly <u>not</u> "based on the determining step." The determining step determines whether the merchant terminal requesting such activation, deactivation, reload, refresh, or refund is properly authorized to perform this transaction. Whether or not the transaction is conducted is dependent upon whether the merchant is determined to be trusted. Van Hoff discloses a determination of whether a network is "trusted" before a user is connected to it; Dorf discloses only aspects of activation and recharge. Neither, and clearly not the combination of the two, provide for the the step "activating, deactivating, reloading, refreshing, or refunding...based on the determining step."

Accordingly, for at least the reasons stated above Applicants respectfully submit that Hirka in view of Dorf and further in view of Van Hoff does not disclose, teach, or suggest the claim elements of claim 1. Because (i) there is no motivation or suggestion to combine Hirka, Dorf, and Van Hoff; (ii) there is no reasonable expectation of success from a combination of Hirka, Dorf, and Van Hoff; and (iii) even if Hirka, Dorf, and Van Hoff are impermissibly combined, they do not teach, disclose or suggest the features of claim 1, the Applicants respectfully request that the rejections of claim 1 under 35 U.S.C. 103(a) be withdrawn.

C. DEPENDENT CLAIMS 8, 16, 17, 19, 20, 22, 25, 27-29, 61, AND 68-71

Dependent claims 8, 1, 17, 19, 20, 22, 26, 27-29, 61 and 68-71 have been rejected as being allegedly unpatentable over Hirka in view of Dorf and further in view of Van Hoff. This rejection is respectfully traversed.

The Applicants submit that claims 8, 1, 17, 19, 20, 22, 26, 27-29, 61 and 68-71 are dependent on claim 1, which has been shown to be patentable over the cited reference. The Applicants therefore submit that claims 8, 1, 17, 19, 20, 22, 26, 27-29, 61, and 68-71 must also be patentable over Hirka in view of Dorf and further in view of Van Hoff and therefore

respectfully request that the rejection of claims 8, 1, 17, 19, 20, 22, 26, 27-29, 61 and 68-71 under 35 U.S.C. 103(a) be withdrawn.

D.   INDEPENDENT CLAIM 31

Independent claim 31 has been rejected as being allegedly unpatentable over Hirka in view of Dorf and further in view of Van Hoff. This rejection is respectfully traversed.

1.   Claim 31

Claim 31 recites, *inter alia*, a computer program code for securely authorizing and distributing stored-value card requests, the program code causing a computer to execute a method comprising "storing in the database a plurality of records comprising...at least one of: identifiers of trusted sources for making stored-value card processing requests and information sufficient to identify trusted communications networks for carrying or transmitting stored-value card processing requests," "receiving a request to activate, deactivate, reload, refresh, or refund the stored-value card over a communications network from a requesting merchant terminal having an associated merchant terminal identifier to the central processor," "determining at least one of whether the respective requesting merchant terminal has a terminal identifier stored in the database; and whether the communications network over which the request is received is identified in the database as a trusted communications," "responsive to a determination that the request was received over a trusted communications network, capturing the requesting terminal identifier and adding the terminal identifier to the database if not already stored," and "activating, deactivating, reloading, refreshing, or refunding at the central processor the stored value card based on the determining step."

2.   Hirka, Dorf, and Van Hoff

As discussed above, Hirka is generally directed to a system of accessing through a financial processing network multiple accounts associated with a single financial card. A user may utilize Hirka's methods to select a particular account from a set of accounts that is associated with a single financial card. The user's selection may be used to route the transaction data through the financial processing network or may be used to read data regarding one of multiple accounts encoded on the card. Dorf is generally directed to a multifunction card system

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that provides a card capable of serving as a prepaid phone card, a debit card, a loyalty card, and a medical information card. The multifunction card may have an identification number comprising a bank identification number that may assist in establishing communications, and can be used from point-of-sale systems, as it is treated as a credit or debit card. Van Hoff is generally directed to a method and apparatus for controlling client computer systems, and enforcing operation of management software before a user is allowed to perform other tasks on the remote network. The method may enforce access rules for third party software to prevent unauthorized retrieval or deletion of information by the third party software.

3.   *Claim 31 is Not Unpatentable Over Hirka In View of Dorf and Further In View of Van Hoff*

In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference; 2) there must be a reasonable expectation of success; and 3) the prior art reference must teach or suggest all the claim limitations. *See* MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). For at least the reasons set forth below, the Office Action fails to make a prima facie case of obviousness for each rejection.

Applicants respectfully submit that the Office Action fails to make a prima facie case for obviousness. First, and as discussed more thoroughly in the discussion of claim 1 above (the substance of which is incorporated into this discussion of claim 31) the Office Action does not properly describe any motivation or suggestion to combine, but instead relies upon impermissible hindsight, as well as uses non-analogous art. Second, and as discussed more thoroughly in the discussion of claim 1 above (the substance of which is incorporated into this discussion of claim 31), there is no reasonable expectation of success in a combination of Hirka, Dorf, and Van Hoff.

Third, even if combined Hirka, Dorf, and Boivin do not disclose all of the claim elements. In particular, the combination fails to disclose at least the claim elements of "storing in the database a plurality of records comprising...at least one of: identifiers of trusted sources for making stored-value card processing requests and information sufficient to identify trusted communications networks for carrying or transmitting stored-value card processing requests,"

"receiving a request to activate, deactivate, reload, refresh, or refund the stored-value card over a communications network from a requesting merchant terminal having an associated merchant terminal identifier to the central processor," "determining at least one of whether the respective requesting merchant terminal has a terminal identifier stored in the database; and whether the communications network over which the request is received is identified in the database as a trusted communications," "responsive to a determination that the request was received over a trusted communications network, capturing the requesting terminal identifier and adding the terminal identifier to the database if not already stored," and "activating, deactivating, reloading, refreshing, or refunding at the central processor the stored value card based on the determining step." Each of these elements are discussed in detail below.

"Storing in the database a plurality of records comprising...at least one of: identifiers of trusted sources for making stored-value card processing requests and information sufficient to identify trusted communications networks for carrying or transmitting stored-value card processing requests"

Applicants respectfully submit that Hirka in view of Dorf and further in view of Van Hoff does not disclose, teach, or suggest "storing in the database a plurality of records comprising...at least one of: identifiers of trusted sources for making stored-value card processing requests and information sufficient to identify trusted communications networks for carrying or transmitting stored-value card processing requests." The Office Action states that "Hirka does not explicitly teach...information identifying trusted sources and information identifying trusted communications networks." *See* Office Action, p. 3. In order to establish the element, the Office looks to Van Hoff, a reference in a non-analogous field of art, and states "Van Hoff teaches the steps of information identifying trusted sources for making stored-value card processing requests and information identifying trusted communications networks for carrying or transmitting stored-value processing requests." Office Action, p. 4. Yet, Van Hoff does not teach the element.

Van Hoff notes in its summary that "[a] list of trusted third party networks is maintained by the client computer system, and the method and apparatus only allows the user to connect to third party networks on the trusted list, eliminating the need for remote users to pass through the corporate network." Van Hoff, col. 3, lines 52-57. This reveals at least two (2) distinct

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differences between Van Hoff and the claim element. First, the present invention and the claim element in particular allow a third party to establish a communication with a user--not the other way around as Van Hoff requires. Second, the present invention does not establish communications between networks, but utilizes the characteristics of a network to determine that the client is indeed legitimate, and is allowed to conduct particular transactions (activation, deactivation, refresh, etc.). While the purpose of Van Hoff is to "eliminate the need for users to pass through the corporate network," the purpose of the claim element at issue is to determine whether the party attempting to conduct a transaction has the proper authorization to do so.

"Receiving a request to activate, deactivate, reload, refresh, or refund the stored-value card over a communications network from a requesting merchant terminal having an associated merchant terminal identifier"

Again, the Office states that "Hirka does not explicitly teach the steps of [the] central processor [being] used to process transactions including the steps of activating, deactivating, reloading, refreshing, or refunding." The Office then looks to Dorf, alleging that Dorf teaches such steps. Office Action, p. 3.

Dorf only discusses recharge and activation: a "means for activating an account corresponding to the phone card" (col. 3, lines 37-38), noting that "the card could only be activated or recharged in predefined increments" (col. 5, lines 61-62). Dorf is silent as to deactivating, refreshing, or refunding. Van Hoff--being from an entirely un-analogous field of art--fails to disclose these actions, or any regarding stored value cards.

Moreover, Dorf fails to disclose the second aspect of the claim--that the request to activate, deactivate, reload, refresh, or refund is received "from a requesting merchant terminal having an associated merchant terminal identifier." Dorf has no disclosure, teaching, or suggestion of this feature. Moreover, Van Hoff does not even mention merchants, merchant terminal, or merchant terminal identifiers.

"Determining at least one of whether the respective requesting merchant terminal has a terminal identifier stored in the database; and whether the communications network over which the request is received is identified in the database as a trusted communications"

Again, the Office states that the base reference of Hirka does not disclose the above step, but looks to Van Hoff. The incorrectly Office asserts that Van Hoff teaches "determining at least one of whether the respective requesting merchant terminal has a terminal identifier stored in the database; and whether the communications network over which the request is received is identified in the database as a trusted communications." Van Hoff does not make such disclosure.

As noted above, Van Hoff states in its summary that "[a] list of trusted third party networks is maintained by the client computer system, and the method and apparatus only allows the user to connect to third party networks on the trusted list, eliminating the need for remote users to pass through the corporate network." Van Hoff, col. 3, lines 52-57. This reveals at least two (2) distinct differences between Van Hoff and the claim element. First, the present invention and the claim element in particular allow a third party to establish a communication with a user-- not the other way around as Van Hoff requires. Second, the present invention does not establish communications between networks, but utilizes the characteristics of a network to determine that the client is indeed legitimate, and is allowed to conduct particular transactions (activation, deactivation, refresh, etc.). While the purpose of Van Hoff is to "eliminate the need for users to pass through the corporate network," the purpose of the claim element at issue is to determine whether the party attempting to conduct a transaction has the proper authorization to do so. Applicants respectfully submit that Hirka in view of Dorf and further in view of Van Hoff does not disclose, teach, or suggest the step of "determining at least one of: whether the respective requesting merchant terminal is a trusted source of requests based on the merchant terminal identifier and whether the communications network is a trusted communications network for carrying or transmitting request."

"Responsive to a determination that the request was received over a trusted communications network, capturing the requesting terminal identifier and adding the terminal identifier to the database if not already stored"

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Simply put, none of Hirka, Dorf, or Van Hoff disclose the step of "responsive to a determination that the request was received over a trusted communications network, capturing the requesting terminal identifier and adding the terminal identifier to the database if not already stored." None of Hirka, Dorf, or Van Hoff disclose anything remotely similar to the recited step.

"Activating, deactivating, reloading, refreshing, or refunding at the central processor the stored value card based on the determining step"

As noted above, none of Hirka, Dorf, or Van Hoff disclose the step "activating, deactivating, reloading, refreshing, or refunding" stored value cards. Moreover, the extent of the disclosure of Dorf of activating is clearly <u>not</u> "based on the determining step." The determining step determines whether the merchant terminal requesting such activation, deactivation, reload, refresh, or refund is properly authorized to perform this transaction. Whether or not the transaction is conducted is dependent upon whether the merchant is determined to be trusted. Van Hoff discloses a determination of whether a network is "trusted" before a user is connected to it; Dorf discloses only aspects of activation and recharge. Neither, and clearly not the combination of the two, provide for the the step "activating, deactivating, reloading, refreshing, or refunding...based on the determining step."

Accordingly, for at least the reasons stated above Applicants respectfully submit that Hirka in view of Dorf and further in view of Van Hoff does not disclose, teach, or suggest the claim elements of claim 31. Because (i) there is no motivation or suggestion to combine Hirka, Dorf, and Van Hoff; (ii) there is no reasonable expectation of success from a combination of Hirka, Dorf, and Van Hoff; and (iii) even if Hirka, Dorf, and Van Hoff are impermissibly combined, they do not teach, disclose or suggest the features of claim 31, the Applicants respectfully request that the rejections of claim 31 under 35 U.S.C. 103(a) be withdrawn.

E.   DEPENDENT CLAIMS 33, 34, 36, 37, AND 39

Dependent claims 33, 34, 36, 37 and 39 have been rejected as being allegedly unpatentable over Hirka in view of Dorf and further in view of Van Hoff. This rejection is respectfully traversed.

The Applicants submit that claims 33, 34, 36, 37, and 39 are dependent on claim 31, which has been shown to be patentable over the cited reference. The Applicants therefore submit that claims 33, 34, 36, 37, and 39 must also be patentable over Hirka in view of Dorf and further in view of Van Hoff and therefore respectfully request that the rejection of claims 33, 34, 36, 37, and 39 under 35 U.S.C. 103(a) be withdrawn.

F.   INDEPENDENT CLAIM 42

Independent claim 42 has been rejected as being allegedly unpatentable over Hirka in view of Dorf and further in view of Van Hoff. This rejection is respectfully traversed. Applicants note that the Office Action appears to inadvertently list claim 43 rather than claim 42 in its rejection. Office Action, p. 4, paragraph 4. Applicants deduce from the substance of the rejection that the Office intended claim 42, and have answered it below as such. Should Applicants' understanding be misguided, the following discussion of claim 42 is to be omitted.

1.   Claim 42

Claim 42 recites, *inter alia*, a system for authorizing stored-value card requests over a network, comprising "a storage module configured to store stored-value card data, and at least one of: identifiers of trusted sources for making stored-value card processing requests and information sufficient to identify trusted communications networks for carrying or transmitting stored-value card processing requests," "a value module configured to define in each stored record a parameter corresponding to the value of each respective stored-value card," and "a central processor configured to accept the request based on whether the request originated from a trusted source and/or whether the request was transmitted or carried by a trusted communications network."

2.   Hirka, Dorf, and Van Hoff

As discussed above, Hirka is generally directed to a system of accessing through a financial processing network multiple accounts associated with a single financial card. A user may utilize Hirka's methods to select a particular account from a set of accounts that is associated with a single financial card. The user's selection may be used to route the transaction data through the financial processing network or may be used to read data regarding one of

multiple accounts encoded on the card. Dorf is generally directed to a multifunction card system that provides a card capable of serving as a prepaid phone card, a debit card, a loyalty card, and a medical information card. The multifunction card may have an identification number comprising a bank identification number that may assist in establishing communications, and can be used from point-of-sale systems, as it is treated as a credit or debit card. Van Hoff is generally directed to a method and apparatus for controlling client computer systems, and enforcing operation of management software before a user is allowed to perform other tasks on the remote network. The method may enforce access rules for third party software to prevent unauthorized retrieval or deletion of information by the third party software.

3.   *Claim 42 is Not Unpatentable Over Hirka In View of Dorf and Further In View of Van Hoff*

In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference; 2) there must be a reasonable expectation of success; and 3) the prior art reference must teach or suggest all the claim limitations. *See* MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). For at least the reasons set forth below, the Office Action fails to make a prima facie case of obviousness for each rejection.

Applicants respectfully submit that the Office Action fails to make a prima facie case for obviousness. First, and as discussed more thoroughly in the discussion of claim 1 above (the substance of which is incorporated into this discussion of claim 42) the Office Action does not properly describe any motivation or suggestion to combine, but instead relies upon impermissible hindsight, as well as uses non-analogous art. Second, and as discussed more thoroughly in the discussion of claim 1 above (the substance of which is incorporated into this discussion of claim 42), there is no reasonable expectation of success in a combination of Hirka, Dorf, and Van Hoff. Third, even if combined Hirka, Dorf, and Boivin do not disclose all of the claim elements. Specifically, the combination does not disclose the claim elements of "a storage module configured to store stored-value card data, and at least one of: identifiers of trusted sources for making stored-value card processing requests and information sufficient to identify trusted communications networks for carrying or transmitting stored-value card processing

requests," "a value module configured to define in each stored record a parameter corresponding to the value of each respective stored-value card," and "a central processor configured to accept the request based on whether the request originated from a trusted source and/or whether the request was transmitted or carried by a trusted communications network." Each of these elements is discussed in detail below.

"A storage module configured to store stored-value card data, and at least one of: identifiers of trusted sources for making stored-value card processing requests and information sufficient to identify trusted communications networks for carrying or transmitting stored-value card processing requests"

Applicants respectfully submit that Hirka in view of Dorf and further in view of Van Hoff does not disclose, teach, or suggest "a storage module configured to store stored-value card data, and at least one of: identifiers of trusted sources for making stored-value card processing requests and information sufficient to identify trusted communications networks for carrying or transmitting stored-value card processing requests." The Office Action states that "Hirka does not explicitly teach...information identifying trusted sources and information identifying trusted communications networks." *See* Office Action, p. 3. In order to establish the element, the Office looks to Van Hoff, a reference in a non-analogous field of art, and states "Van Hoff teaches the steps of information identifying trusted sources for making stored-value card processing requests and information identifying trusted communications networks for carrying or transmitting stored-value processing requests." Office Action, p. 4. Yet, Van Hoff does not teach the element.

Van Hoff notes in its summary that "[a] list of trusted third party networks is maintained by the client computer system, and the method and apparatus only allows the user to connect to third party networks on the trusted list, eliminating the need for remote users to pass through the corporate network." Van Hoff, col. 3, lines 52-57. This reveals at least two (2) distinct differences between Van Hoff and the claim element. First, the present invention and the claim element in particular allow a third party to establish a communication with a user--not the other way around as Van Hoff requires. Second, the present invention does not establish communications between networks, but utilizes the characteristics of a network to determine that the client is indeed legitimate, and is allowed to conduct particular transactions (activation,

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deactivation, refresh, etc.). While the purpose of Van Hoff is to "eliminate the need for users to pass through the corporate network," the purpose of the claim element at issue is to determine whether the party attempting to conduct a transaction has the proper authorization to do so.

"A value module configured to define in each stored record a parameter corresponding to the value of each respective stored-value card"

The Office does not address the element of a "value module" in any way, and accordingly does not identify any portion of Hirka, Dorf, or Van Hoff that discloses a "value module configured to define in each stored record a parameter corresponding to the value of each respective stored-value card."

"A central processor configured to accept the request based on whether the request originated from a trusted source and/or whether the request was transmitted or carried by a trusted communications network."

None of Hirka, Dorf, or Van Hoff disclose the element "a central processor configured to accept the request based on whether the request originated from a trusted source and/or whether the request was transmitted or carried by a trusted communications network." Moreover, the extent of the disclosure of Dorf of activating is clearly <u>not</u> "based on the determining step." The determining step determines whether the merchant terminal requesting such activation, deactivation, reload, refresh, or refund is properly authorized to perform this transaction. Whether or not the transaction is conducted is dependent upon whether the merchant is determined to be trusted. Van Hoff discloses a determination of whether a network is "trusted" before a user is connected to it; Dorf discloses only aspects of activation and recharge. Neither, and clearly not the combination of the two, provide for the element of a "central processor configured to accept the request <u>based</u> on whether the request originated from a trusted source and/or whether the request was transmitted or carried by a trusted communications network."

Accordingly, for at least the reasons stated above Applicants respectfully submit that Hirka in view of Dorf and further in view of Van Hoff does not disclose, teach, or suggest the claim elements of claim 42. Because (i) there is no motivation or suggestion to combine Hirka, Dorf, and Van Hoff; (ii) there is no reasonable expectation of success from a combination of

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Hirka, Dorf, and Van Hoff; and (iii) even if Hirka, Dorf, and Van Hoff are impermissibly combined, they do not teach, disclose or suggest the features of claim 42, the Applicants respectfully request that the rejections of claim 42 under 35 U.S.C. 103(a) be withdrawn.

G. DEPENDENT CLAIMS 43, 44, 50, 51, 53, 54, AND 56

Dependent claims 43, 44, 50, 51, 53, 54 and 56 have been rejected as being allegedly unpatentable over Hirka in view of Dorf and further in view of Van Hoff. This rejection is respectfully traversed.

The Applicants submit that claims 43, 44, 50, 51, 53, 54, and 56 are dependent on claim 42, which has been shown to be patentable over the cited reference. The Applicants therefore submit that claims 43, 44, 50, 51, 53, 54, and 56 must also be patentable over Hirka in view of Dorf and further in view of Van Hoff and therefore respectfully request that the rejection of claims 43, 44, 50, 51, 53, 54, and 56 under 35 U.S.C. 103(a) be withdrawn.

H. NEW CLAIMS 72-76

New independent claim 72 and dependent claims 73-76 are additionally patentable over Hirka in view of Dorf and further in view of Van Hoff. Claim 72 recites, *inter alia*, the elements of a database record comprising "information identifying at least a first group of merchant terminals authorized to make particular stored-value card processing requests...and information identifying at least a first group of communications networks for carrying or transmitting stored-value card processing requests, particular stored-value card processing requests received over which are assumed authorized." Moreover, claim 72 recites the step of "determining at the central processor at least one of: whether the respective requesting merchant terminal is part of the first group of merchant terminals authorized to make particular stored-value card processing requests based on the merchant terminal identifier; and whether the communications network over which the stored-value card processing request is received is part of the first group of communications networks, particular stored-value card processing requests received over which are assumed authorized."

Hirka, Dorf, and Van Hoff, individually and in combination do not disclose these elements. Accordingly, claims 72-76 are patentable over Hirka in view of Dorf and further in view of Van Hoff.
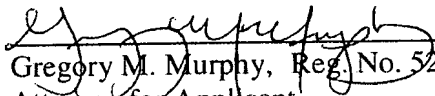
III. CONCLUSION

For at least the reasons set forth above, the Applicants respectfully submit that claims 1, 3, 4, 8, 16, 17, 19, 20, 22, 25, 27-34, 36, 37, 39, 42-44, 50, 51, 53, 54, 56, 61, and 68-71, and new claims 72-76 are in condition for allowance. The Applicants request that the present Amendment be entered.

Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact the Applicant's undersigned representative. Authorization is hereby granted to charge or credit the undersigned's Deposit Account No. 50-0206 for any fees or overpayments related to the entry of this Amendment, including any extension of time fees and new claims fees.

Respectfully submitted,

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